PATENT

Atty Docket No.: 10005208-1
App. Ser. No.: 09/891,325

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks. Currently, claims 1-11 are pending in the present application of which claim 1 is independent.

Claims 1-3, 5, and 7 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Johnson et al. (U.S. Patent Number 6,034,882), hereinafter "Johnson'882."

Claims 4, 6, and 8-11 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johnson (U.S. Patent Number 6,689,644 in view of Johnson (U.S. Patent Number 6,689,644), hereinafter "Johnson'644."

The above rejections are respectfully traversed for at least the reasons set forth below.

Claim Rejection Under 35 U.S.C. §102(e)

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

> Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

The Second Office Action rejects claims 1-3, 5, and 7 as allegedly being anticipated by Johnson'882. It is respectfully submitted that Johnson'882 does not disclose each and every element in claims 1-3, 5, and 7, arranged as in the claims, for at least the following reasons:

The Second Office Action alleges that FIG. 4(a) of Johnson'882 teaches the claimed on-chip capacitor recited in claim 1 of the present application. More specifically, in FIG. 4(a) of Johnson'882, the input terminal 20 is allegedly cited as the claimed "first electrode," the steering element 22 and state change element 23 are allegedly cited as the claimed "dielectric layer," and the output terminal 21 is allegedly cited as the claimed "second electrode" that forms the claimed "on-chip capacitor" with the input terminal 20.

It is respectfully submitted that in contrast to an on-chip capacitor as claimed, Johnson'882 is directed to a vertically stacked field programmable nonvolatile memory. *See, e.g.,* Johnson'882, Title and Abstract. Indeed, as stated in the Brief Description of the Drawings of Johnson'882,

> "FIG. 4(a) is a perspective view of one embodiment of a memory cell built in accordance with the present invention." (Emphasis added). Johnson'882, col. 4, ll. 30-31.

Thus, in contrast to the first and second electrodes of an on-chip capacitor as claimed, the input terminal 20 and output terminal 21 in Johnson'882 are actually input and output terminals of a memory cell. *See, e.g.,* Johnson'882, col. 7, ll. 33-47. Furthermore, in contrast to the claimed dielectric layer as claimed, the steering element 22 in Johnson'882 is actually a

semiconductor element, and the state change element 23 is actually a memory element that can be placed in more than one state and includes conducting terminals for receiving electrical signals to effect such change of state. Johnson'882, col. 5, ll. 59-65; col. 8, ll. 24-31. Therefore, the input terminal 20, output terminal 21, steering element 22, and state change element 23 together cannot form an on-chip capacitor as claimed.

Accordingly, it is respectfully submitted that Johnson'882 does not disclose each and every element of claim 1, and its dependent claims 2-3, 5, and 7. Thus, these claims are allowable over the references of record.

Claim Rejection Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. §103 is set forth in MPEP §706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

However, as set forth in MPEP §2141.01, before establishing a *prima facie* case of obviousness with the cited references, "it must be known whether a patent or publication [that is used as a cited reference] is in the prior art under 35 U.S.C. § 102." Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987). Thus, if a reference is not

qualified as prior art under 35 U.S.C. § 102, it is not qualified as prior art under 35 U.S.C. § 103.

The Second Office Action alleges that claims 4, 6, and 8-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson'882 in view of Johnson'644. This rejection is respectfully traversed for at least the following reasons:

First, because claims 4, 6, and 8-11 depend on claim 1, it follows that claims 4, 6, and 8-11 are allowable for the same reasons set forth above for the allowability of claim 1.

Second, it is respectfully submitted that Johnson'644 is not qualified as prior art under 35 U.S.C. § 103 because it is not qualified as prior art under 35 U.S.C. § 102. Specifically, Johnson'644 was filed on April 22, 2002 as a divisional application of a parent application that was filed on August 13, 2001. Thus, the earliest date for which Johnson'644 qualifies as prior art under 35 U.S.C. § 102, specifically, 102(e), is August 13, 2001. The present application was filed on June 27, 2001. Therefore, Johnson'644 is not qualified as prior art under 35 U.S.C. § 102(e) with regards to the present application. It follows that Johnson'644 cannot be combined with Johnson'882 to reject claims 4, 6, and 8-11 under 35 U.S.C. § 103(a).

Accordingly, it is respectfully submitted that claims 4, 6, and 8-11 are allowable over the references of record.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

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Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: July 18, 2005 By

Ashok K. Mannava
Registration No.: 45,301

MANNAVA & KANG, P.C.
8221 Old Courthouse Road
Suite 104
Vienna, VA 22182
(703) 652-3822
(703) 880-5270 (facsimile)